



PATENT
Attorney Docket No. 35693.830003.US0
Express Mail Label No. EV269463710US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Byrnes & Sullivan

Serial No. 10/660,411

Filed: SEPTEMBER 10, 2003

For: REDUCED SKIN ABRASION SHOE

Group Art Unit: 3728

Examiner: not yet assigned

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR 1.47 (b)

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTN: E. Shirene Willis

Sir:

In response to the Decision Refusing Status Under 37 CFR 1.47 (b), mailed February 25, 2004, the period for which to respond extends until April 25, 2004. The applicant submits herewith a new Combined Declaration and Power of Attorney for Patent Application Executed by 37 CFR 1.47 (b) Applicant. Applicant respectfully wishes this Petition be considered and granted. Any fee deficiency may be charged to Deposit Account No. 08-2623.

March 3, 2004


Brian P. Kinnear, Reg. No. 43,717
ATTORNEY FOR APPLICANTS
HOLLAND & HART LLP
555 Seventeenth Street, Ste. 3200
Denver, Colorado 80201-8749
Telephone: (303) 295-8170
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OFFICE OF PETITIONS

In re Application of
Byrnes & Sullivan
Application No. 10/660,411
Filed: September 10, 2003
Attorney Docket No. 35693.830003.US0
For: REDUCED SKIN ABRASION SHOE

DECISION REFUSING	Jan 30-04
STATUS UNDER	MC
37 CFR 1.47(b)	4-25-04

This is in response to the petition under 37 CFR 1.47(b), filed January 30, 2004.

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on September 10, 2003 without an executed oath or declaration. Accordingly, on December 2, 2003, a "Notice to File Missing Parts of Nonprovisional Application" (Notice) was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, a declaration executed by Jerry Edwards, president of DashAmerica, Inc., a company with proprietary interest in the invention, the surcharge, the petition fee, and the instant petition were filed on January 30, 2004. The petition sets forth the last known address of each non-signing inventor and explains that each inventor received the application papers, but did not respond to the request that he/she sign the oath or declaration for the patent application.

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration;
- (2) an acceptable oath or declaration;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest; and
- (6) proof of irreparable damage.

Applicant lacks item (2) set forth above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration signed by Mr. Edwards does not list Ms.

Byrnes and Mr. Sullivan's information. The declaration must set forth each inventor's residence, citizenship and mailing/ post office address. As listing the citizenship for each inventor is a statutory requirement under 35 USC 115, it cannot be waived An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicant on behalf of Ms. Byrnes and Mr. Sullivan is REQUIRED. See MPEP 409.03(b).

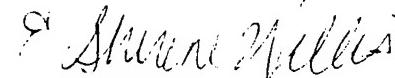
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450
ATTN: E. Shirene Willis

By hand: Crystal Plaza 1 Lobby
2011 South Clark Place
Room 1B03
Arlington, VA 22202
ATTN: E. Shirene Willis

By FAX: (703) 872-9306
ATTN: Office of Petitions -- E. Shirene Willis

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 308-6712.



E. Shirene Willis
Senior Petitions Attorney
Office of Petitions



**COMBINED DECLARATION AND POWER
OF ATTORNEY FOR PATENT APPLICATION
EXECUTED BY 37 C.F.R. § 1.47(b) APPLICANT**

DECLARATION:

I am a corporate officer of DashAmerica, Inc., who is the 37 C.F.R. § 1.47(b) applicant of the present invention. I acknowledge that the below named inventors were the original, first and joint inventors of the subject matter which is claimed and for which a patent is sought on the invention entitled REDUCED SKIN ABRASION SHOE, the specification of which was filed September 10, 2003, and has a patent application serial number 10/660,411.

The persons named as inventors in this application are TRACY BYRNES and SEAN SULLIVAN.

The last known address of Tracy Byrnes, who is a citizen of the U.S.A., is 1286 Banner Circle, Erie, CO 80516.

The last known address of Sean Sullivan, who is a citizen of the U.S.A., is 843 Racquet Lane, Boulder, CO 80303.

At the time the present invention was developed, the inventors of this application were employees of DashAmerica, Inc. and they worked under my supervision.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, and a copy of the present application was sent to the last known inventors of the application to allow them to review and comment on the above-identified application.

Pursuant to the employment agreements of the inventors, they acknowledged ownership of the invention associated with the present application resided with DashAmerica, Inc. and agreed to execute the necessary paperwork to assign the entire right, title, and interest in the present application to DashAmerica, Inc.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56. If this application is identified above as a continuation-in-part application above, I acknowledge the duty to disclose to the Office all information known to us to be material to patentability as defined in §1.56 which became available between the filing date of the prior application and the filing date of this continuation-in-part application.

No prior foreign application for patent or inventors' certificate has been filed.

No Priority claim is made.

POWER OF ATTORNEY:

As the 37 C.F.R. §1.47(b) applicant, I hereby appoint Brian P. Kinnear, Reg. No. 43,717, Francis A. Sirr, Reg. No. 17,265, Chris Kulish, Reg. No. 33,056, L. Grant Foster, Reg. No. 33,236, Trent Baker, Reg. No. 46,534, James R. Farmer, Reg. No. 47,555, Thomas Osborne, Reg. No. 39,796; and Christopher Wight, Reg. No. 31,680; to prosecute this application and transact all business in the Patent and Trademark Office connected therewith. Send all correspondence to: Brian Kinnear, HOLLAND & HART LLP, 555 17th Street, Suite 3200, Denver, Colorado 80202-3979, and direct telephone calls to Brian Kinnear, telephone number 303-295-8170.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Applicant's Full Name:	DashAmerica, Inc.
Applicant's Corporate Officer	Jerry Edwards President
Inventor's Signature:	<i>Jerry Edwards</i>
Date:	<i>March 1, 2004</i>
Residence: (City, State and/or Country)	620 Compton Street Broomfield, CO 80020
Citizenship:	USA
Post Address Office:	(same as above)

§ 1.56 duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The office encourages applicants to carefully examine:

(1) prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

- (i) Opposing an argument of unpatentability relied on by the Office, or
(ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
 - (2) Each attorney or agent who prepares or prosecutes the application; and
 - (3) Each other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.
- (d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent or inventor.

03-05-04



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Attorney Docket No. 35693.830003.US0
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Byrnes & Sullivan

Group Art Unit: 3728

Serial No. 10/660,411

Examiner: not yet assigned

Filed: SEPTEMBER 10, 2003

For: REDUCED SKIN ABRASION SHOE

CERTIFICATE OF MAILING BY EXPRESS MAIL

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTN: E. Shirene Willis

Sir:

1. Request for Reconsideration of Petition Under 37 CFR 1.47 (b);
2. Copy of Decision Refusing Status Under 37 CFR 1.47 (b)
3. New Combined Declaration and Power of Attorney for Patent Application Executed by Applicant;
4. Certificate of Mailing by Express Mail; and
5. Return Card,

relating to the above application, were deposited as "Express Mail," Mailing Label No. EV269463710US with the United States Postal Service, addressed to Mail Stop PETITION, Commissioner for Patents, P.O. Box 1450, ATTN: E. Shirene Willis, Alexandria, VA 22313-1450, March 3, 2004.

March 3, 2004

Mailer

Michele Clark

Brian P. Kinnear

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555 Seventeenth Street, Ste. 3200
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March 3, 2004